

III. REMARKS

1. The finality of the Office Action mailed January 23, 2008 is premature. A final rejection is not proper when a 35 USC 102(e)/103(a) rejection is properly refuted by reason of common ownership under 35 USC 103(c) and applicant did not amend the claims in the last response or submit information in an IDS that is now being used by the Examiner.

a) A final rejection is not proper when a 35 USC 102(e)/103(a) rejection is properly refuted by reason of common ownership under 35 USC 103(c);

In the Office Action mailed September 21, 2007, claims 17 and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bull (US Pat Pub No. 2003/0148774) (the '774 Publication") in view of Boltz (U.S. Patent No. 6,311,055) ("Boltz"). However, in the response filed on December 21, 2007, Applicant refuted this ground of rejection by reason of "**common ownership under 35 USC §103(c).**" As stated in the response filed on December 21, 2007:

The rejection of claims 17 and 34 over the combination of US Patent Pub. No. 2003/0148774 (the '774 publication) in view of Boltz (US Patent No. 6,311,055) under 35 U.S.C. §103(a) is not proper because both the '774 Publication and the instant application are commonly owned. (It is noted that the Office action states that patent publication number 2003/0148774 is to Bull et al. This is not correct. The '774 Publication is to Naghian et al.)

Pursuant to 35 U.S.C. §103(c) subject matter which was prior art under former 35 U.S.C. **103** via 35 U.S.C. **102(e)** is disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

In this case, '774 Publication can only qualify as prior art under 35 U.S.C. §102(e). The '774 Publication is owned by Nokia Corporation. The instant application is also commonly owned by Nokia Corporation. Thus, the instant application and '774 Publication, were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Therefore, pursuant to 35 U.S.C. §103(c) Bull does not qualify as prior art for purposes of 35 U.S.C. §103(a).

The rejection of claims 17 and 34 over '774 Publication and Boltz under 35 U.S.C. §103(c) is improper and should be withdrawn.

Since a statement averring common ownership was submitted to overcome the rejection of claims 17 and 34 in the response filed on December 21, 2007, the next action **may not be a final action**. "When applying any 35 U.S.C. 102(e)/103 references against the claims of an application the Examiner should anticipate that a statement averring common ownership at the time the inventors was made may disqualify any patent or application applied in a rejection under U.S.C. 103 based on 35 U.S.C. 102(e). **If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made.**" MPEP §706.07(a)

Therefore, pursuant to MPEP §706.07(a), the finality of the rejection mailed January 28, 2008 is clearly erroneous and must be withdrawn (706.07(c)). **A new Office Action with a new response period must be issued (706.07(d)).**

- b) Furthermore, the present action cannot be a final action because it is **not** necessitated by an amendment of the claims or on information submitted by Applicant in an IDS. Under present practice, second or any subsequent actions on the merits shall be final, **except where** the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information

submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**. (See MPEP 706.07(a)). Applicant did not amend any claims in the response filed on December 21, 2007 and the new rejection is not based on an information disclosure statement filed by Applicant. Thus, the current ground of rejection is not necessitated by Applicant's amendment of claims or submission of an information disclosure statement. Thus, this current office action may not be made final.

- c) There are clear errors in the Office Action mailed January 28, 2008 that require correction and a proper opportunity for Applicant to respond. The Office Action mailed January 28, 2008 includes errors that must be corrected before a clear issue can be developed between the Examiner and the Applicant. In the absence of the correction of those errors and the development of a clear issue, the current Office action cannot be and should not be a final action. (See M.P.E.P 706.07).
 - i) In the Office Action mailed January 23, 2008 the Examiner states that Claims 1-16 and 18-33 are rejected under 35 USC §102(e) as being anticipated by Bull et al. (US Patent Number 2003/0148774). However, US Patent "Publication" number 2003/0148774 is not to Bull et al. Rather, it is to "Naghian et al." The rejection continually refers to "Bull." This is a clear factual error that requires correction. Due to at least this error in the Office Action mailed January 23, 2008, there is no way for a clear issue to develop between the Examiner and the Applicant. A new, corrected action is required. (See MPEP 707.06 and 707.07)
 - ii) In the Office Action mailed January 23, 2008, the Examiner states that Claims 17 and 34 are rejected under 35 U.S.C. 103(a) over Bull et al. (US 2003/0148774) in view of Boltz (US Patent No. 6,311,055).

However, US Patent Publication 2003/014877 is to Naghian et al. NOT Bull et al. In the Office Action mailed January 23, 2008, in both the introductory paragraph on page 7, and the paragraphs following, the Examiner refers to "Bull." As noted above, US Patent

Publication 2003/014877 is commonly owned by the Applicant and is not a proper reference for purposes of 35USC §103(a).

The Examiner made the very same mistake in the Office Action mailed September 21, 2007. Applicant pointed out this mistake to the Examiner in the response filed on December 21, 2007. In the Office Action mailed September 21, 2007, on page 7, item 4, the Examiner refers to "Bull et al. (US Patent Number 2003/0148774)." First, the number "2003/0148774" is not a patent number. It is a publication number. Second, as noted above, US Patent Publication 2003/014877 is to Naghian et al, not Bull et al. Third, in the response filed on December 21, 2007, on page 9, line 4-6, it was pointed out to the Examiner that there was a mistake on this point. The Examiner has not bothered to show any attention to the correction of at least this particular issue.

iii) Applicant also notes that the rejection of claims 17 and 34, page 7, item 4, refers to "Korpela" in the body of the argument. This is another mistake or error in the Office Action mailed January 23, 2008 that requires corrective action.

Due to these errors in the Office Action, there is no way for a clear issue to have been developed between the Examiner and the Applicant. A new, corrected action is required. (See MPEP 707.06 and 707.07).

In view of the foregoing, the finality of the current action is clear error and must be corrected with the issuance of a new, non-final office action.

2. Claims 1-16 and 18-33 are not anticipated by Bull et al. Assuming that the Examiner is referring to US Patent Publication Number 2006/0003775, it is respectfully submitted that this reference does not anticipate the subject matter recited in Applicants claims. Claim 1 recites that "a subscriber terminal comprises means for transmitting a request message or location service to the core network via the radio network." This is not disclosed or suggested by Bull. Bull, in paragraph [0029] referred to by the Examiner, discloses that wireless devices may be identified and located based on their presence in a defined geographic area. The location area is loaded and a list of IMSIs, MSISDNs and

associated TMSIs that can initiate a network transaction in the geographic area of interest. A network transaction for this feature may be defined as a call origination or termination, a SMS exchange, and a location update. There is no disclosure here related to a subscriber terminal comprising means for transmitting a request message for location service to the core network via the radio network as claimed by applicant.

Claim 1 also recites that the "network part comprises means for performing at least one function required in the request message and means for transmitting a response message to the subscriber terminal via the radio network." This is not disclosed or suggested by Bull. Bull only discloses, in paragraph [0073] referred to by the Examiner, that user equipment can be defined as equipment such as a UMTS mobile device. A RNC handles protocol exchanges between interfaces and is responsible for centralized operation and maintenance of the entire radio network system. This is not what is recited by applicant in the claim.

Claim 1 also recites that "packet-switched connections are used between the core network, the radio network and the subscriber terminal for transmitting the request message and the response message." This is not disclosed or suggested by Bull. It is noted that the examiner has not identified any particular portion of Bull that might disclose or suggest this particular feature. It is submitted that this feature does not exist in Bull. Thus, the claim cannot be anticipated.

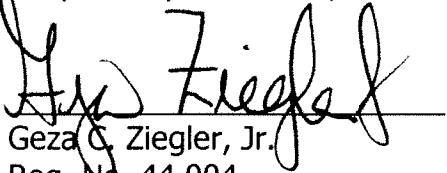
The examiner states that paragraph [0028] of Bull discloses transmitting a request message for location service. This is not correct. Paragraph [0028] only states that a system can be configured to locate mobile devices in a network. Any Time Interrogation queries are submitted to the home location register. This can result in a call being placed to the wireless device by the network using supplementary services. There is no disclosure here or elsewhere of transmitting a request message for location services. Thus, Bull does not anticipate claims 1-16 and 18-33.

It is also submitted that Bull, US Patent Pub. No. 2006/0003775, is **not prior art** for purposes of 35 USC §102(e). The filing date of Bull is June 10, 2005, which is **AFTER** Applicant's filing date of January 26, 2001, with a claim of priority to Finnish Patent Application Number 20000149, dated **January 26, 2000**. Bull is a "continuation-in-part" application of U.S. Patent No. 6,782, 264 filed on July 18, 2001, which is a "continuation-in-part" application of US Patent No. 6,317,604 filed on March 31, 2000, which is a "continuation-in-part" application of US Patent No. 6,184,829 filed on January 8, 1999. The only reference in this line of "continuation-in-part" patents and applications that precedes Applicant's filing date is US Patent 6,184,829 (the '829 Patent) filed on January 8, 1999. However, as has been previously noted (see the response filed on April 7, 2006), the '829 Patent does not disclose or suggest each element recited by Applicant in the claims. It is submitted that the subject matter relied upon by the Examiner in Bull is **not present in the earlier filed application** and thus is NOT entitled to the filing date of the earlier application. Thus, Bull does not qualify, and cannot be used, as a prior art reference against Applicant's claimed subject matter. Therefore, claims 1-16 and 18-33 cannot be and are not anticipated by Bull.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

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Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

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Date: March 7, 2008

Signature: Shannon D'Amico

Shannon D'Amico
Name